



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,902	10/19/2001	Jean Weissenbach	R-341894	7144

7590 08/24/2004

Norman H Stepno
Burns Doane Swecker & Mathis
PO Box 1404
Alexandria, VA 22313-1404

EXAMINER

QIAN, CELINE X

ART UNIT	PAPER NUMBER
----------	--------------

1636

DATE MAILED: 08/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

8/19.

Office Action Summary

Application No.

09/830,902

Applicant(s)

WEISSENBAACH ET AL.

Examiner

Celine X Qian

Art Unit

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 12-30, 32-69 and 71 is/are pending in the application.
- 4a) Of the above claim(s) 1-9, 12-30 and 33-40 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 48-69 and 71 is/are allowed.
- 6) ☒ Claim(s) 32 and 41-46 is/are rejected.
- 7) ☒ Claim(s) 47 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1636

DETAILED ACTION

Claims 1-9, 12-30, 32-69, 71 are pending in the application. Claims 1-9, 12-30, 33-40 are withdrawn from consideration for being directed to non-elected subject matter. Claims 32, 41-69, 71 are currently under examination.

This Office Action is in response to the Amendment filed on 6/1/04.

Response to Amendment

The objection to the specification has been withdrawn in light of Applicant's amendment of the specification.

The objection to claims 10, 11, 31, 32, 47, 54, 62, 69 and 71 has been withdrawn in light of Applicant's amendment of the claims.

The rejection of claims 10, 11, 31, 32, 41-71 under 35 U.S.C. 112 2nd paragraph has been withdrawn in light of Applicant's amendment of the claims.

The rejection of claims 41-46 under 35 U.S.C. 102 (a) is maintained for reasons discussed below.

Claim 32 is rejected under 35 U.S.C. 112 2nd paragraph for reasons discussed below.

Claim 47 is objected to for reasons discussed below.

Response to Arguments

Priority

Applicants state that a certified, English copy of the priority document is submitted. However, it is not found in the application.

Art Unit: 1636

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 41-46 are rejected under 35 U.S.C. 102(a) as being anticipated by Hazan et al.

In response to this argument, Applicants argue that the submission of the English translation perfects the priority date of the application. Thus, the priority date predates the publication date of the reference, and rendering this rejection moot.

As stated above, the English translation of the priority document is not found on the record. This rejection is maintained until this document is received by the office and placed on the record.

New Grounds of Rejection Necessitated by Applicant's Amendment

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 32 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Art Unit: 1636

The written description requirement is set forth by 35 U.S.C. 112, first paragraph which states that the: “*specification* shall contain a written description of the invention. . . [emphasis added].” The written description requirement has been well established and characterized in the case law. A specification must convey to one of skill in the art that “as of the filing date sought, [the inventor] was in possession of the invention.” See *Vas Cath v. Mahurkar* 935 F.2d 1555, 1560 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). Applicant may show that he is in “possession” of the invention claimed by describing the invention with all of its claimed limitations “by such descriptive means as words, structures, figures, diagrams, formulas, etc., that fully set forth the claimed invention.” See *Lockwood v. American Airlines Inc.* 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997).

In analyzing whether the written description requirement is met, it is first determined whether a representative number of species have been described by their complete structure. Next, it is determined whether a representative number of species have been sufficiently described by other relevant identifying characteristics. The claim recites “a homolog of SEQ ID NO:1” and “a variant of SEQ ID NO:1.” However, the specification only discloses a sequence of SPG4 gene that is represented by SEQ ID NO:1. The specification fails to disclose any other “homolog” or “variant” or this sequence. The specification also fails what common characteristics these homologs or variants must share. As such, the specification fails to describe the claimed invention by their complete structure or other identifying characteristics. Therefore, the written description requirement is not met.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 1636

Claim 32 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation of “an RNA sequence corresponding to SEQ ID NO:1/at least 15 consecutive nucleotide of SEQ ID NO:1” or “corresponding to a homolog/variant of SEQ ID NO:1” renders the claim indefinite because it is unclear what is the size or sequence of the claimed RNA molecule. SEQ ID NO:1 is the genomic sequence of SPG4 gene which is more than 100kb in size. It is unclear if the “corresponding” RNA molecule is translated from said gene, a splice variant of the gene, or shares sequence homology with the mRNA of the gene. The specification does not teach any homolog or variant of SEQ ID NO:1. As such, the nature of the RNA “corresponding” to such homolog or variant is unknown. Therefore, the metes and bounds of the claim cannot be established.

Claim Objections

Claim 47 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Claims 48-69 and 71 are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 1636

This application contains claims 1-9, 12-30 and 33-40, drawn to an invention nonelected with traverse in the response filed on 8/11/03. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

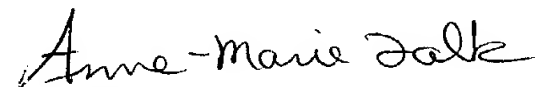
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celine X Qian whose telephone number is 571-272-0777. The examiner can normally be reached on 9:30-6:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel Ph.D. can be reached on 571-272-0781. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1636

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Celine Qian, Ph.D.



ANNE-MARIE FALK, PH.D
PRIMARY EXAMINER